

# Notice of Allowability

Application No.

10/686,466

Examiner

Teresa E. Strzelecka

Applicant(s)

KURN, NURITH

Art Unit

1637

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed March 21, 2007.
2. ☒ The allowed claim(s) is/are 17-30,32,33,35,37-40,45-53,66 and 67.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All   b) ☐ Some\*   c) ☐ None   of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date 10/14/03
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

### **EXAMINER'S AMENDMENT**

1. This office action is in response to an amendment filed March 21, 2007. Claims 17-30, 32, 33, 35, 37-40, 45-53, 56-60 and 64-67 were previously pending, with claims 22, 23, 25, 27, 29, 32, 35, 37, 56-60, 64 and 65 withdrawn from consideration.
2. Applicant's amendment to the specification obviated the previously presented objection.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on October 14, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Terminal Disclaimer***

4. The terminal disclaimer filed on March 21, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the U.S. Patent No. 6,251,639 has been reviewed and is accepted. The terminal disclaimer has been recorded.

This terminal disclaimer obviates the previously presented obviousness-type double patenting rejections.

5. No other rejections were previously pending. Since the previously examined claims 17-21, 24, 26, 28, 30, 33, 38-40, 45-53, 66 and 67 are allowable, the previously withdrawn claims 22, 23, 25, 27, 29, 32, 35 and 37 are rejoined with the other method claims examined previously. Therefore, claims 17-30, 32, 33, 35, 37-40, 45-53, 66 and 67 are allowed. Claims 56-60, 64 and 65, drawn to the non-elected product claims are cancelled, in view of the election without traverse on September 11, 2006.
6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure

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consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

- Cancel claims 56-60, 64 and 65.

### ***Reasons for Allowance***

7. The following is an examiner's statement of reasons for allowance: Applicant's invention is a method of nucleic acid amplification using a template-switch primer which contains single-strand of an RNA polymerase promoter. The primer bound to the target sequence is extended by a second primer proceeding along the same strand, forming a double-stranded promoter sequence at the end of the extended double-stranded fragment. The closest prior art reference, Kacian et al. (U.S. Patent No. 5,480,784) teaches using a primer with a single-stranded promoter region, but the double-stranded promoter region is formed, in the closest embodiment, by extension of the template along the primer, not using another primer on the same strand.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa E. Strzelecka whose telephone number is (571) 272-0789. The examiner can normally be reached on M-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Teresa E Strzelecka  
Primary Examiner  
Art Unit 1637

*Teresa Strzelecka*  
*6/22/07*